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| APPLICATION NO. FILING DATE | | ILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO | |
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| 09/514,759 02/28/200 | | 02/28/2000 | John Vivian Wood | SWIN 2012 | 9358 | |
| 7812 | 7590 | 02/13/2004 | | EXAMINER | | |
| SMITH-HII | | | THALER, MICHAEL H | | | |
| 12670 N W E SUITE 104 | BARNES | ROAD | ART UNIT | PAPER NUMBER | | |
| PORTLAND | o, OR 9' | 7229 | 3731 | 15 | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

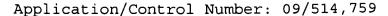
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| ## Examiner Staminer Stamine | • | | Applicati | n No. | Applicant(s) | $(\mathcal{C}_{\mathcal{C}})_{\mathcal{C}}$ | | | | | |
| Michael Thaler 3731 | | 0.00 | 09/514,75 | 59 | WOOD ET AL. | CA | | | | | |
| The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ② MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. Extensions of time may be available under the provisions of 37 CPR 1.13(d), in no evert, however, may a reply be timely filed after 5X (8) MONTHS from the mailing date of this communication of 37 CPR 1.13(d), in no evert, however, may a reply be timely filed after 5X (8) MONTHS from the mailing date of this communication, only within the administration of the 1X (9) MONTHS from the mailing date of this communication of the 1X (9) MONTHS from the mailing date of this communication of the 1X (9) MONTHS from the mailing date of this communication, even if films) filed, may reduce any exercise placet term adjustment. See 37 CPR 1.74(d). Status 1) □ Responsive to communication(s) filled on 13 January 2004. 2a) □ This action is FINAL. 2b) □ This action is non-final. 3) □ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213. Disposition of Claims 4) □ Claim(s) 15-52 is/are pending in the application. 4a) Of the above claim(s) 46-52 is/are withdrawn from consideration. 5) □ Claim(s) is/are allowed. 6) □ Claim(s) is/are objected to by the Examiner. 7) □ The specification is objected to by the Examiner. Application Papers 9) □ The specification is objected to by the Examiner. 10) □ The drawing(s) filed on □ is/are: a) □ accepted or b) □ objected to by the Examiner. Application Papers 9) □ The specification is objected to by the Examiner. Note the attached Office Action or form PTO-152. Priority under 35 U.S.C. § 119 12) □ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) □ All b) □ some c) □ None of: 1.□ Certified copies of the priority documents have been received. 2.□ Certified co | | Office Action Summary | Examiner | | Art Unit | 1/15 | | | | | |
| Period for Reply A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. Extensions of time may be available under the provisions of 37 CFR 1.36(a). In no evert, however, may a reply be timely filed If the period for reply specified above. The maximum statutory period will apply and will expres SIX (6) MONTHS from the mailing date of this communication. If NO period for reply specified above. The maximum statutory period will apply and will expres SIX (6) MONTHS from the mailing date of this communication. If NO period for reply specified above. The maximum statutory period will apply and will expres SIX (6) MONTHS from the mailing date of this communication. If NO period for reply specified above. The maximum statutory period will apply and will expres SIX (6) MONTHS from the mailing date of this communication. If NO period for reply specified above. The maximum statutory will apply and will expres SIX (6) MONTHS from the mailing date of this communication. Failus to reply will the time of a communication. Status 1) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213. Disposition of Claims 4) Claim(s) 15-52 is/are pending in the application. 4a) Of the above claim(s) 48-52 is/are withdrawn from consideration. 5) Claim(s) is/are allowed. 6) Claim(s) is/are allowed. 6) Claim(s) is/are allowed. 7) Claim(s) is/are allowed. 8) Claim(s) is/are allowed. 10) The previous field on is objected to by the Examiner. Application Papers 9) The specification is objected to by the Examiner. Application Papers 9) The specification is objected to by the Examiner. Application Papers 10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner. Application may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.32(a). 11) Certified copies of the priori | | | | | | | | | | | |
| THE MAILING DATE OF THIS COMMUNICATION. Extensions of time may be available under the provisions of 37 CPR 1.38(a). In so evert, however, may a reply be timely filled after SIX (6) MONTHS from the mailing date of this communication. If the provide or prely precified work or least that may (50) dignt, a reply within the statutor, minimum of histly (30) dags will be considered timely. Failurs to reply within the set or extended principle or provided to the communication. Failurs to reply within the set or extended principle or provided by the Office later than three mortal sets the mailing date of this communication, even if timely filled, may reduce any example placet term adjustment. See 37 CFR 1.704(b). Status 1) Responsive to communication(s) filled on 13 January 2004. 2a) This action is FINAL. 2b) This action is non-final. 3) Is ince this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213. Disposition of Claims 4) Claim(s) 15-52 is/are pending in the application. 4a) Of the above claim(s) 48-52 is/are withdrawn from consideration. 5) Claim(s) is/are allowed. 6) Claim(s) is/are allowed. 6) Claim(s) is/are objected to. 8) Claim(s) is/are objected to. 8) Claim(s) is/are objected to. 8) Claim(s) is objected to by the Examiner. 10 The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner. Application Papers 9) The specification is objected to by the Examiner. 10 Application Papers 9) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). 2) All b) Some * C) None of: 1. Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No. 3. Copies of the certified copies of the priority documents have been received. Attachment(s) 1) Notice of forespections of Paper Note Note of Theorem Paper Note Note of Individual D | | | ppears on the | e cover sheet with the | correspondence ad | dress | | | | | |
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| Paper No(s)/Mail Date 6) Uher: | 1) Notice 2) Notice 3) Inform | e of References Cited (PTO-892) e of Draftsperson's Patent Drawing Review (PTO-948) nation Disclosure Statement(s) (PTO-1449 or PTO/SB/0 | 08) | Paper No(s)/Mail I | Date | O-152) | | | | | |

Application/Control Number: 09/514,759

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Claims 48-52 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP 821.03.

Claims 15-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bendel et al. (5,242,458). Bendel et al. show a biocompatible gripping device for surgical use including at least one deformable gripping element (at I) comprising shape memory material (col. 3, lines 55-63). The amount of functional porosity of the material is not disclosed in the reference. However, it would have been obvious that there exists at least a very small amount of functional porosity in the Bendel et al. material since materials in general are porous to some degree (even if it is a very small degree) and the amount of functional porosity is not claimed. The deformable gripping element (at I) can, in fact, be returned to its non-deformed condition on heating after releasing the article, as broadly claimed. During its intended use, the gripping element I returns to its nondeformed condition after releasing the article as indicated in col. 3, lines 61-63. However, the gripping element, when used in a cold environment (below the martensite to austenite phase transition temperature) would inherently remain in its deformed condition after releasing the article since it would be in the martensite phase. Further, it would inherently return to its



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non-deformed condition upon heating (to room temperature for example) since heating it would change its state from the martensite to austenite. Since the rejected claims are apparatus claims rather than method of use claims and since the Bendel et al. device is inherently capable of being used as claimed, the rejection is proper.

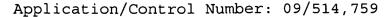
Claims 15-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bendel et al. (5,242,458) in view of Davis (4,839,479). Assuming arguendo that the material of the Bendel et al. inserts I has absolutely no functional porosity, it would have been obvious to provide such porosity to the material in order to enhance the speed of recovery of the insert after deformation in view of the Davis teaching of making shape memory materials porous for this reason (col. 6, lines 40-63).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's arguments filed Jan. 13, 2004 have been fully considered but they are not persuasive for the reasons set forth above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this



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action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703)308-2496. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

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mht 2/6/04 MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731

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